

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:)
F.L. Conte)
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) *Art Unit: 3643*
)
Application No.: 10/643,288)
Confirmation No: 4031)
)
Filed: 08/20/2003)

Title: **Duplex Lash Insect Swatter**

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

SECOND REPLY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In accordance with 37 CFR 41.41, and in response to the examiner's Answer dated 27 July 2007 [the two-year anniversary of the first Answer], applicant hereby submits this Reply Brief.

ARGUMENT

The examiner's Answer is remarkable for many reasons including the failure to previously present the many new arguments therein; the failure to afford due weight to express claim features; the failure to consider the applied references in the whole; and the failure to address Appellant's traverse of the unwarranted rejections.

The examiner now attempts to rebut the nonanalogous art White and Watkins by rote conclusion with the fabricated "problem" of "killing insects," when the relevant case law does not so condone, nor has the examiner applied the facts and holdings of Oetiker.

The scope of the prior art may be determined from applying *In re Wood and Eversole*, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA, 1979):

The determination that a reference is from a nonanalogous art is therefore twofold. First, we decide if the reference is within the field of the inventor's endeavor. If it is not, we proceed to determine whether the reference is reasonably pertinent to the particular problem with which the inventor was involved.

The examiner is not permitted to recharacterize the applicant's problem in an attempt meet this test; and this, the examiner has done by merely alleging the problem of killing insects, when no such problem is found in White and Watkins.

In *Ex parte Dussaud*, 7 USPQ2d 1818 (BPAI 1988), the Board cites the Woods case, among others, and states that:

We also find that the examiner's characterization of the problem ... is broader than the particular problem with which the appellants were involved. Precise definition of the problem is important in determining whether a reference is from a nonanalogous art. Defining the problem too narrowly may result in excluding consideration of relevant prior art. By the

same token, defining the problem too broadly, as done here, may result in considering prior art as "analogous" which is inconsistent with real world considerations. [cases omitted].

The Federal Circuit in *Monarch Knitting Machinery Corp. v. Sulzer Morat GmbH*, 139 F.3d 877, 45 USPQ2d 1977, 1981 (Fed. Cir. 1998) provides further guidance in applying the Wood test that:

Defining the problem in terms of its solution reveals improper hindsight in the selection of the prior art relevant to obviousness By importing the ultimate solution into the problem facing the inventor, the district court adopted an overly narrow view of the scope of the prior art. It also infected the district court's determinations about the content of the prior art.

The present examiner has been caught in the same traps found in these cases: he has redefined the problems in the applied references too broadly for merely killing insects with the toy guns; and by using hindsight to import the "solution" of killing insects, when the mere object of killing insects is unrelated to the specific problems confronting the applicant, which problems are expressly presented in the specification.

Although the examiner attempts to address some of applicant's arguments in the Answer, he has failed to address all the arguments, and has failed to address the substance thereof.

In accordance with MPEP 707.07(f) and *In re Hermann*, 261 F.2d 598, cited therein, the examiner has failed to meet his evidentiary burden and the corresponding rejections must be reversed for want of evidence and want of proper legal analysis.

At page 4 of the Answer, the examiner cites case law without any application of the facts therein or stated nexus with the present claims, and begins new arguments not previously proffered in the continued piecemeal prosecution

of the application failing to meet the complete examination practice mandated by Rule 104.

The new contentions being belatedly proffered by the examiner are brazen in their superficiality and mere conclusions, and fail to address any claim in particular and fail to meet the stringent requirements under Section 103 for a proper examination in the whole of each and every claim being rejected.

How will the Board interpret these latest examiner contentions, and with regard to which claims?

The latest contentions by the examiner are proof positive of the examiner's repeated bias against allowing any claim for the improved insect swatter, and fabricating any reason whatsoever to deny any such claims.

Now, the examiner baldly uses "the knowledge generally available to one of ordinary skill in the art" as license to reject all the claims, without identifying that knowledge, and without meeting any of the requisites of Section 103.

No patent application would ever result in allowable claims based on such misuse of examination practice, and mere examiner argument.

Examiner argument is never evidence, and this examiner has repeatedly shown the remarkable ability to reject claim after claim without regard to the requisite legal requirements; and only the Board of Appeals, three times now has reversed this same examiner to duly allow patentable claims.

A fourth reversal of the examiner's unwarranted rejections is now well merited, especially when the Board uncovers the remarkable lack of evidence and legal analysis found in the examiner's repeated rejections.

Further poisoning the examiner's rejections is the admitted failure by the examiner to afford any weight to the claimed features under the mere contention that the "references ... both are merely rubber band guns which

function in the same way" when there is no such evidence to support such unbridled conjecture.

The two references are two patents duly issued by the US Patent Office because the Patent Office has previously found that the two guns therein are different from each other, and function differently from each other; otherwise the Patent Office would have conducted malfeasance in issuing two patents for the same invention.

Clearly, this examiner has the subjective belief that no further rubber band gun is entitled to any patent protection because such rubber band guns merely use rubber bands.

The two guns in the references do not function in the same manner, and are not similarly configured, which is well apparent from even a cursor review of the specifications thereof, and as additionally noted in the main brief.

The examiner has not shown otherwise, and the examiner's belated attempt to so state is without any evidence identified by the examiner, since there cannot be any such evidence in the two references when evaluated in the whole.

Note also that the examiner is now indicating what the references are "not cited" for, which is a clear admission of selective hindsight reconstruction.

The whole analysis requires just that: an evaluation of a reference in the whole, not in isolation.

The examiner is clearly using the references (any references) for naked parts, and selecting the parts from those references in the clear hindsight reconstruction of Appellant's various claims (not identified by the examiner) under the mere conclusion of "general knowledge" for that reconstruction.

This is clearly erroneous, and an abuse of patent examination practice.

The examiner now applies Watkins for the slot 34 with

the mere conclusion that "the only difference being that in the present invention [which claim?], the slot opens to the bottom ... while in Watkins, the slot opens to the top"

The "only difference?"

Clearly not; and the examiner has therefore expressly admitted the failure to consider each claim in the whole, and the fundamental differences thereof over the applied references, as presented in the main brief.

More speculation the examiner proffers: "Watkins would function to destroy insects just like the present invention be it the pea of the forward projecting lash as shown in Fig. 4."

The present invention is found in different species with different combinations in the various claims being rejected by the examiner, but not being addressed individually by the examiner.

None of the present claims recites any structure or method for shooting a "pea" in the manner of Watkins, and the examiner's mere arguments are therefore irrelevant and misleading.

As for the proximal and distal ends of the lash presented by the examiner in the sentences bridging pages 4 and 5, the examiner has yet again failed to address any claim in particular, and has failed to address the particular combinations recited therein in the repeated rush to reject the claims, all the claims, without proper evidence or analysis.

"Either end of the lash can be considered as a proximal end ..." in White, the examiner opines, but the examiner has failed to address the specific cooperation of elements in any claim, and the fundamental differences over the references.

The examiner's reference to "page 1, lines 86-98" of White is without any stated relevance to any claim or any legal basis under Section 103.

That section of White presents the use of the toy gun

in White for one, two, or three rubber bands and their initial connection and stretching, and then continuing to page 2, line 4, the trigger is pulled and the bands "will be projected by reason of their own resilience to a considerable distance."

"Projected ... to a considerable distance."

That is not possible in Appellant's claims because of the recited cooperation of elements which effect a whip, with the proximal end of the lash remaining attached to the rod. None of this has the examiner afforded any weight in the rush to reject the claims.

The examiner further contends it is "not the case" that "White would be rendered inoperative if the three rubber bands where [sic] prevented from being shot away."

The examiner attempts to reverse the burden of proof by alleging, now, that the Appellant, not the examiner, has not submitted any evidence.

White itself is the fundamental evidence proffered by the examiner himself, and White itself is due evidence that the toy gun therein would be rendered inoperative if the three bands were somehow permanently attached to the gun to prevent their liberation.

In complete disregard of this fundamental teaching of White, the examiner attempts to distort that teaching, without evidentiary or legal support, by applying "page 1, lines 1-22" of White and the mere use of the "discharged" feature.

But that "discharged" feature is no evidence that the three-bands may remain attached to the gun, as the examiner baldly contends.

"Discharged" as clearly used in White means that the bands will be "catapulted through the air," page 1, ll. 17 & 18, to "a considerable distance," page 2, ll. 1-4.

And, more importantly, the examiner has overlooked the express structure of the toy gun in White, and the

cooperation of elements therein, and the function thereof.

Figure 1 of White clearly illustrates that structure and the special elements thereof, and the express mounting of the three bands between the extension 10 and the sight 4.

The only possible function of the toy gun in White is to discharge and catapult away to a considerable distance the three bands, without any remaining attachment to the gun.

The examiner has presented no evidence whatsoever in White that the three bands could in fact remain attached to the sight 4 after discharge.

This line of mere argument by the examiner clearly shows that the examiner is evaluating naked elements, and especially naked words from White, as well as from Watkins, without regard to context, without regard to the whole, and solely and only with Appellant's claims in mind to fabricate in clear hindsight a combination of elements not disclosed, taught, or suggested by the references singly or in combination.

No, the examiner, instead, must rely on "general knowledge," to fabricate the rejections without identifying that general knowledge, when clearly that general knowledge is the examiner's own subjective knowledge based on Appellant's specification itself, Appellant's claims, and the piecemeal selection of naked elements from any reference that the examiner can find and apply to reject all the claims without regard to the individual recitations therein.

This is more abuse of examination practice by the examiner as evidenced by the examiner's own subjective remarks, made under the mere proffer of case law without any regard to the proper application of that case law.

At page 5, the examiner then merely states, yet again without evidentiary basis, that the "rubber bands of White can be considered to be identical ..." when that is clearly not disclosed or suggested, nor even possible; and the figures of White clearly show otherwise.

The examiner has expressly failed to identify any claim in which the examiner himself equates "length" with "identical" when the two features are clearly not the same, as evidenced by any common dictionary.

When the bands in White are cut "perpendicular to the length of the [old inner tire] tube" as the examiner baldly contends, it would be a practical impossibility that any two bands would be identical or have the same length.

Firstly, it would be impossible to cut the tubes "perpendicular" when the old tire tube is flexible and resilient, and this, the examiner and Board can readily determine by trying the experiment themselves, if necessary.

And, it would also be impossible to cut two bands identical to each other.

The examiner has clearly overlooked Appellant's own specification and problems presented therein.

Appellant does not propose making the bands manually, which would be against the teachings of the specification.

One problem is specialty bands and their associated cost, and that problem is solved by using common and standard smaller bands joined together in the manner disclosed and recited in the claims for the stated advantages thereof.

That White "found one [band] that met his requirements" is not relevant to Appellant's claims, or the rejection thereof under Section 103, and the examiner has not shown otherwise.

"One, two, or three rubber bands" is also not relevant in and of itself, as presented in the main brief, and the examiner has not shown otherwise.

The examiner's contention is further evidence of the selection of naked elements without regard to the stringent requirements of Section 103, and this failure by the examiner is more and more conspicuous by merely reading the examiner's various contentions in light of the Section 103 requirements.

The examiner yet again states that "White is not cited

to show ... bands fixed at one end and loose at the other."

Yet, what about the whole analysis mandated under Section 103?

Clearly, the examiner is selectively combining naked elements from the two references, and the examiner must provide evidence and shown legal motivation to make that combination, and the examiner clearly has not.

The examiner states that Watkins is being applied for the fixed-loose feature, but must also disregard the other features of Watkins, including the leather loop 16 which is not rubber, nor in any way is relevant to the three bands in White.

"It is unlikely that an insect would know the difference from a liberated lash or from a lash used like a whip," the examiner baldly opines.

This comment by the examiner is evidence of the complete disregard of Appellant's specification in its entirety and the problems being solved and the solution therefor as found in the various claims.

This is quite remarkable, and a further clear abuse of examination practice in the admitted failure to objectively evaluate Appellant's application under Rule 104 and Section 103.

Why not just hit the insect with a shoe?

Would the insect "know the difference?"

Why not just hit the insect with a bullet from a high powered rifle?

Would the insect "know the difference?"

The examiner has clearly lost track of the fundamental examination practice under Section 103; looking at only the result without any regard to the plethora of apparatuses or methods to achieve that result.

Does the examiner possibly contend that if the end result is the same, the means to achieve that same end result would not be patentable irrespective of the differences

therein?

The answer to that question appears yes since the examiner opines at page 6 that the "rubber band guns of White and Watkins are not fundamentally different from each other"

If this is an accurate representation of the examiner's rationale for rejecting the various claims, it would appear certain that the Board must reverse all rejections made by the examiner for his admitted failure to afford any weight to the clear and fundamental differences between not only references White and Watkins, but also the further differences recited in Appellant's claims over these references.

Clearly, this examiner is looking blindly at naked similarities, without regard to the fundamental differences.

Is not the essence of modern patent law under the U.S. Constitutions the promotion of differences over the prior art for the advantages thereof in promoting technology?

Why is this examiner looking solely at the similarities, and expressly disregarding the differences?

To be fair, examination practice before the PTO affords examiners due deference in broadly construing claims in applications, and broadly construing prior art references.

But, under the present facts, we have the same examiner who has repeatedly rejected each and every one of Appellant's claims in the parent, and now in this improvement application; with three previous Boards of Appeal reversing the examiner three times, with the present, fourth Board charged once again to fairly evaluate the stated rejections and Appellant's rebuttal.

The abuse of examination practice by the present examiner is now well supported by this protracted history, and it seems that even the various Boards of Appeal under the USPTO are powerless to stop this continued abuse.

Prosecution before the PTO is quite expensive and

unduly complex; and the need for appeal further complicates that practice. Four appeals now are clear evidence of a systemic failure in the PTO which allows this unwarranted practice to continue.

Can it end, or will it ever end?

The examiner's final conclusions on page 6 are clearly self serving and without any evidentiary basis. "But so long as it takes into account only the knowledge which was within the level of ordinary skill ..., and does not include knowledge gleaned only from applicant's disclosure, such a [hindsight] reconstruction is proper."

The examiner's own fabricated arguments are clear evidence of the failure to comply with this provision.

Without Appellant's claims as the guide, one skilled in the art, and especially this examiner, would not have even the hint of how to modify the two references for any reason. And, it does not appear even possible to modify these references to obtain Appellant's novel insect swatter for solving the stated problems, without such modification of those references rendering the toy guns therein inoperable for their intended, and different, purposes.

As for Robinson, Appellant has shown that this reference is nonanalogous art, and the examiner's remarks fail to comply with applicable case law.

Robinson is clearly fundamentally different from White and Watkins, and from Appellant's claims, and the examiner has not shown otherwise.

Instead, the examiner yet again looks only to basic similarities that rubber band guns may simply be grouped together irrespective of PTO classification or differences, and that the cord in Robinson is elastic and serves the same function as the bands in White and Watkins.

Yet, these statements by the examiner are not relevant to the applicable case law on non-analogous art, and the examiner has not shown otherwise.

It is quite apparent from the various bald contentions being proffered by this examiner that Appellant's claims are being summarily rejected because this examiner refuses to afford any weight, let alone due weight, to the specific problems being solved by the improved insect swatter and method recited in the claims.

This examiner has refused to afford any weight to the structural and functional cooperation of elements in the various apparatus claims; and has also refused to afford any weight to the method of use claims having no counterpart in the references being applied.

Appellant's apparatus claims define a special insect swatter whip which employs the whipping action of the lash to effectively swat insects, as specifically recited in the method claims.

Similar, the examiner opines for the three references?

Clearly not.

In White, the three bands are simply and wholly discharged away. No whipping action whatsoever, and the lost bands must then be manually retrieved to be used again.

In Watkins, the leather pouch 16 hurls the pea projectile. Yet again, no whipping action whatsoever, and the pea or a replacement pea must be used for the next shot.

And, in Robinson the huge ball D is hurled away from the gun. No whipping action, and another ball D must be used for the next shot.

Only the present examiner can, and has, looked at these fundamentally different references, and merely argued the similarity of the use of elastic bands therein for the "general knowledge" basis to reject each and every one of Appellant's claims.

This examiner has clearly not afforded any weight to the differences in these three references, nor the fundamental and significant differences in Appellant's claims over these references.

And, this examiner continues to refuse to allow even one claim for this insect swatter whose basic configuration resulted in the issuance of a U.S. Patent after two favorable rulings by two past Boards.

That basic swatter is now being specifically improved, and Appellant is clearly entitled to the allowance of suitable claims therefor based in part on the patentable novelty of the parent swatter, and based in most part on the specific improvements therein presented in the present claims.

The specification clearly addresses many problems, and the corresponding solutions therefor, none of which has this examiner afforded any weight under the guise of the "general knowledge" which fails to address any of Appellant's problems or present any basis to modify the three disparate references in any manner relevant to Appellant's claims.

Fundamental to the examiner's many, many errors, is the examiner's attempt to so modify the basic reference White and render it inoperable for its intended purpose by fixing the bands to the gun to prevent the liberation therefrom.

The examiner has also presented the corresponding rejection to so modify the reference Watkins using the multiple bands from White without any regard for the essential leather pouch 16 used to propel the pea. Without that pouch 16 and pea, the toy gun in Watkins would also be rendered inoperative for its intended purpose.

Time and time again, this examiner, as examiners before him, have shown their trained ability to fabricate rejections for any reasons.

But, the MPEP is admirable in the multitude of sections therein for guiding examiners in properly evaluating claims, and ch. 2100 presents significant guidance on the fundamental need for written evidence to support rejections, and the equally fundamental showing of legal motivation in modifying and combining references.

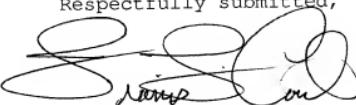
Even a cursory application of the relevant MPEP provisions as they support examination under Section 103 will clearly show the patentable novelty of the recited insect swatter for the significant improvements recited therein over the patented parent insect swatter, and, especially, over the applied references.

Accordingly, all of the rejections of record should be reversed for the reasons presented in both the main brief and this reply brief.

And, it is sincerely hoped that prosecution is not again reopened after this fourth appeal, which, to be certain, would lead to a fifth appeal as well.

Does not the completeness standard under Rule 104 have any significance, and what sanctions should be made against the PTO for failure to comply therewith?

Respectfully submitted,



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